

**Notice of Allowability**

Application No.

10/027,289

Examiner

Yvette C. Thornton

Applicant(s)

BEKKU ET AL.

Art Unit

1752

e10

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to appeal brief filed on May 17, 2004.
2. ☒ The allowed claim(s) is/are 1-3 and 6-8.
3. ☒ The drawings filed on 20 December 2001 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☒ Certified copies of the priority documents have been received in Application No. 09/548,952.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |  |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment                               |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material          | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance   |
|   | 9. <input type="checkbox"/> Other _____.   |

### REASONS FOR ALLOWANCE

This is written in reference to application number 10/027289 filed on December 20, 2001 and published as US 2002005507 A1 on May 9, 2002, which is a continuation of US Patent No. 6413693 B1.

#### *Response to Appeal Brief*

1. The Appeal Brief filed on May 17, 2004 has been entered and fully considered.
2. Upon reconsideration of the pending claims in light of the before-mentioned appeal brief, the examiner withdraws the rejections of record.

#### *Allowable Subject Matter*

3. Claims 1-3 and 6-8 are allowed.
4. The following is an examiner's statement of reasons for allowance: The prior art reference of Yukinobu clearly teaches the use of a coating of ultra-fine ITO particles and a thermosetting resin binder applied to a substrate by the methods of wire bar coating, doctor blade coating, or roller coating. The examiner is of the position that the inherency argument set forth previously cannot be maintained due to the presence of the said binder. The examiner has found no evidence to support the position that a binder/ITO combination would inherently have a resistance of  $3.0 \times 10^{-4}$  ohm-cm or less when the substrate is heated to a temperature of 150°C or more. Furthermore, the claimed invention pertains to a transparent conductive film, which does not allow for the presence of the taught binder of Yukinobu.
5. The examiner further takes the position that the taught invention of Yukinobu teaches away from using the conventional sputtering method as set forth in the instant claims.

6. The prior art reference of Furukawa et al. (US 6673426 B1) clearly anticipates the claimed invention. See Figures 1-9 and c. 10, l. 1-c. 11, l. 6. Furukawa however is not citable as prior art under the statute of 35 USC 102.

7. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### *Conclusion*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvette C. Thornton whose telephone number is 571-272-1336. The examiner can normally be reached on Monday-Thursday 8-6:30.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Yvette C. Thornton". The signature is fluid and cursive, with a large, sweeping "Y" and a stylized "T" at the end.

Yvette Clarke Thornton

Primary Examiner

Art Unit 1752

yct

August 4, 2004